

ESTTA Tracking number: **ESTTA745901**

Filing date: **05/11/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91207836
Party	Plaintiff Volvo Trademark Holding AB
Correspondence Address	LEIGH ANN LINDQUIST SUGHRUE MION PLLC 2100 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20037-3202 UNITED STATES tm@sughrue.com, llindquist@sughrue.com
Submission	Testimony For Plaintiff
Filer's Name	LEIGH ANN LINDQUIST
Filer's e-mail	tm@sughrue.com, vmullineaux@sughrue.com
Signature	/Leigh Ann Lindquist/
Date	05/11/2016
Attachments	Deposition of M. Dempe Exhibit 73 part 1.pdf(2807307 bytes) Deposition of M. Dempe Exhibit 73 part 2.pdf(3507988 bytes) Deposition of M. Dempe Exhibit 74 part 1.pdf(2823092 bytes) Deposition of M. Dempe Exhibit 74 part 2.pdf(4389996 bytes) Deposition of M. Dempe Exhibit 74 part 3.pdf(4924786 bytes) Deposition of M. Dempe Exhibit 75.pdf(3909460 bytes) Deposition of M. Dempe Exhibit 76 part 1.pdf(3018961 bytes) Deposition of M. Dempe Exhibit 76 part 2.pdf(4796570 bytes) Deposition of M. Dempe Exhibit 77 part 1.pdf(3040269 bytes) Deposition of M. Dempe Exhibit 77 part 2.pdf(5438251 bytes)

EXHIBIT 73



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Volvo Trademark Holding AB v. Hong Kong Names LLC.

Case No. D2008-0735

1. The Parties

Complainant is Volvo Trademark Holding AB, of Goteborg, Sweden, represented by Sughrue Mion, PLLC, United States of America.

Respondent is Hong Kong Names LLC., Hong Kong, People's Republic of China

2. The Domain Name and Registrar

The disputed domain name <volvo-penta.com> is registered with Moniker Online Services, LLC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 12, 2008 naming Respondent as "HK Names LLC" at a Domain Privacy Service address that was the same as the registrar's address, namely, "Jupiter, Florida, USA". On May 14, 2008, the Center transmitted by email to Moniker Online Services, LLC a request for registrar verification in connection with the domain name at issue. On May 15, 2008, Moniker Online Services, LLC transmitted by email to the Center its verification response confirming that the current Respondent was in fact listed as the registrant and providing the contact details as an (incomplete) address in Hong Kong People's Republic of China ("Hong Kong"). In response to a notification by the Center that the Complaint was administratively deficient, Complainant filed an amendment to the Complaint on May 22, 2008 by changing the name and address of Respondent to match that provided by the Registrar of record. The Center verified that the Complaint so amended satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified Respondent of the Complaint at the "Jupiter, Florida, USA" address, its "Hong Kong, PRC" address as well as by email to "postmaster@volvo-penta.com" and "hknames@gmail.com". According to the documents accompanying the case file, the Hong Kong address was deficient by reason of it lacking a street name, and delivery could not be effected in that city. The email to "postmaster@volvo-penta.com" was apparently undeliverable. The only physical address at which a confirmed delivery was achieved was the "Jupiter, Florida, USA" address of the Domain Privacy Service and the only successful email delivery was apparently to "hknames@gmail.com". The proceedings commenced on May 27, 2008. In accordance with the Rules, paragraph 5(a), the due date for Response was June 16, 2008. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on June 18, 2008.

The Center appointed Philip N. Argy as the sole panelist in this matter on June 20, 2008. The Panel finds that it was

properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The following facts, taken from the Complaint, are uncontested:

Complainant is a trademark holding company owned jointly in equal shares by AB Volvo and Volvo Car Corporation. It is the formal holder of all trademarks for the Volvo group of companies, of which AB Volvo Penta and Volvo Car Corporation are each a member. Member companies of the group are formally licensed to use relevant trademarks from the Group's trademark portfolio in their respective businesses.

Complainant's applications/registrations for VOLVO, PENTA and various combinations of them are extensive. The earliest use of the PENTA mark dates back to 1907 and the VOLVO mark 1927. PENTA is associated with quality marine propulsion and associated engine products and VOLVO with quality motor vehicles and associated engine products.

Complainant or its licensees attends all premier boat shows worldwide; VOLVO PENTA is the official engine for the famous Volvo Ocean Race.

The VOLVO mark, alone and in combination with other terms and designs, is registered extensively as a trademark and service mark in the United States America ("United States") and elsewhere throughout the world, by virtue of which it is one of the best known trademarks in the world today. Similarly, the VOLVO PENTA and PENTA marks are each the subject of extensive registrations in various countries and have also each become famous trademarks in their own right.

Previous panels have so found, at least in relation to the VOLVO trademark, in no less than 20 earlier decisions.

5. Parties' Contentions

A. Complainant

Complainant's submissions and contentions are, in summary, that its three main trademarks, namely, VOLVO, PENTA, and VOLVO PENTA are famous marks, that Respondent's <volvo-penta.com> domain name is confusingly similar to Complainant's VOLVO and PENTA marks, and that Respondent has no rights or legitimate interests in the <volvo-penta.com> domain name.

Given the lack of a Response, Complainant's submissions can be abbreviated for present purposes as follows:

(i) The disputed domain name is confusingly similar to a trademark in which Complainant has rights:

The domain name <volvo-penta.com> wholly incorporates Complainant's registered trademarks VOLVO and PENTA, which Complainant submits is sufficient to establish confusing similarity for the purpose of the Policy despite the addition of the hyphen. Complainant also says that the disputed domain is identical to its VOLVO PENTA mark on the basis that the hyphen should be ignored.

(ii) Respondent has no right or legitimate interest in respect of the disputed domain name

Respondent has no rights or legitimate interest in the <volvo-penta.com> domain name based on Complainant's/licensee's continuous and long prior use of its mark and trade name VOLVO, and its VOLVO PENTA and PENTA trademarks.

Further, none of the situations described in paragraph 4(c) of the Policy can be established.

Complainant asserts that Respondent cannot conceivably claim to have been unaware of Complainant's famous marks, nor of the fact that they are owned by an entity in the AB Volvo group.

Respondent is clearly not making any legitimate noncommercial or fair use of the domain name <volvo-penta.com>; it is parked at a Sedo website (a commercial domain monetization site).

Respondent is not known as VOLVO PENTA and is not using <volvo-penta.com> in connection with any *bona fide* offering of goods or services; Complainant urges the Panel to follow the finding in *State of Florida Department of Management*

Services v. Bent Petterson, WIPO Case No. D2008-0039, which found that Sedo's portal website does not constitute the *bona fide* offering of goods and services. Respondent is also not making legitimate noncommercial or fair use of the disputed domain name; In fact Respondent receives click through commission.

(iii) The disputed domain name was registered in bad faith

Respondent registered the disputed domain name on March 3, 2005. There is no reason for Respondent to use Complainant's mark in its domain name other than to try to sell it to Complainant and prevent Complainant from registering the domain name <volvo-penta.com> or for other commercial gain.

"On information and belief" Respondent chose the domain name <volvo-penta.com> with full knowledge of Complainant's rights therein. At the time of registration Respondent was on constructive notice of Complainant's famous marks by virtue of Section 22 of The Lanham Act, 15 United States Code section 1072.

It is further inconceivable that Respondent was unaware of Complainant's three famous marks. Nor could Respondent's selection of <volvo-penta.com> been in anything other than bad faith because there is no reason for Respondent to have chosen that term except to attract consumers to its website. Respondent purposely registered <volvo-penta.com> for commercial gain.

Complainant cites both *Volvo Trademark Holding AB v. Roger Nichols*, WIPO Case No. DTV2001-0017 and *Volvo Trademark Holding AB v. Soeren Groenlund*, WIPO Case No. DNU2002-0003 as examples of cases where previous panels have found bad faith registration and use based on the same submissions from Complainant.

Complainant also relies on Respondent's "blatant violation" of paragraph 19 of the Registration Agreement to which Respondent assented in registering the disputed domain name. It contains an express warranty by Respondent that "to the best of its knowledge and belief neither the registration of the domain name nor the manner in which it intends to use such domain name will directly or indirectly infringe the legal rights of a third party ...".

(vi) The disputed domain name is being used in bad faith

There is simply no explanation for registration and use of the <volvo-penta.com> domain name by Respondent except bad faith. Respondent is using the domain name to resolve to a Sedo landing page which features links to other sites selling Volvo Penta branded goods and other Volvo branded goods. According to Complainant, other panelists in "WIPO ICANN proceedings" involving Sedo parking pages have found such conduct to be evidence of bad faith, and Complainant cites two examples: *Lyonnaise de Banque v. Richard J.*, WIPO Case No. D2006-0142 and *Wal-Mart Stores, Inc v. Terry Davies*, WIPO Case No. D2006-0031.

In addition, Complainant submits, the Sedo website indicates that the domain name is for sale, which puts Respondent in breach of paragraph 4(b)(i) of the Policy – for the purpose of selling or renting the domain name. Complainant cites *NFL Properties LLC and New York Jets LLC v. Link Commercial Corp*, WIPO Case No. D2004-1087 where the learned panel found bad faith proven where the disputed domain name in that case resolved to a site which stated "This domain name is for sale!/You can also rent this domain name or co develop it with us/.../To be considered your bid must be at least US\$2,000/ Note most asking process are between US\$10,000 and US\$75,000".

Respondent is alleged to have registered the domain name "with the express purpose of not permitting Complainant to register and use the domain name". Respondent's use of the domain name is also "blatantly opportunistic", to adopt a phrase that has been used in a number of prior panel decisions.

Respondent's bad faith registration and use is clear despite a disclaimer provided at Sedo landing page because the disclaimer does nothing to counter Respondent's lack of legitimate rights, bad faith registration or bad faith use of the domain name.

Respondent's bad faith is further evidenced by the fact that <volvo-penta.com> is a blatant infringement of Complainant's trademark rights and dilutes the strength of Complainant's trademark rights. It is inevitable that the public will assume that the disputed domain is owned by or used under license from Complainant or one of its licensees.

Complainant goes on to assert that Respondent will "continue and expand its damaging acts unless Respondent's infringing domain name is transferred to Complainant".

B. Respondent

There has been no response of any kind to the Center's communications and, in particular, no response to the allegations made in the Complaint.

6. Discussion and Findings

Although Complainant's submissions are formally uncontested, it has the burden of demonstrating that the requirements of paragraph 4(a) of the Policy are made out, and the Panel believes it proper to consider the submissions, and the evidence, and to make formal findings. Also, under paragraphs 10 and 15(a) of the Rules, the Panel regards this as a desirable course to take in any event.

A. Identical or Confusingly Similar

Complainant has extensively demonstrated its rights in the trademarks VOLVO, PENTA and VOLVO PENTA. Although Complainant cited the "fame" of its marks as the first ground for its complaint, it had to do no more than demonstrate that it had rights in the marks, and that the disputed domain name was identical or confusingly similar to those trademarks. The evidence of Complainant's rights in the marks is overwhelming in its geographical, quantitative and temporal extent. The use of PENTA by Complainant's predecessors in business can be traced back to 1907. Although the use of trademark holding companies can sometimes be problematical where a Complainant needs to rely, for example, on common law marks in the form of goodwill owned by associated entities, here there is no difficulty given the numerous formal registrations held by Complainant. Nothing else matters in so far as the first limb of the complaint is concerned.

The Panel has no hesitation in finding the disputed domain to be confusingly similar to Complainant's well established trademarks VOLVO and PENTA, and identical to its VOLVO PENTA trademark.

B. Rights or Legitimate Interests

Respondent has not asserted any basis for its use of VOLVO or PENTA in the disputed domain name. This is one area where the lack of a response to a complaint involving famous trademarks makes it difficult for a Panel not to find in a complainant's favour.

For the reasons advanced by Complainant, the Panel comfortably concludes that Respondent has no rights or legitimate interests in respect of the disputed domain name, and so finds.

C. Registered and Used in Bad Faith

The marks VOLVO and PENTA have been in use for more than 100 years in United States. No plausible explanation for Respondent's conduct has been proffered. There is no inference available to the Panel other than that the use of <volvo-penta.com> to direct users to a Sedo landing page is simply domain monetization unconnected with any *bona fide* supply of goods or services by Respondent. Respondent sits passively collecting click-through revenue generated solely from Complainant's goodwill and Internet users' inaccurate guessing of the correct domain name associated with Complainant or its licensees in any particular locality.

The Complaint goes beyond what is needed and in parts extends beyond what the annexed evidence or cited cases support. Also, Complainant demonstrates that all links on the Sedo landing page to which the disputed domain resolves in fact promote the sale of genuine products of Complainant's licensees. This is not an example of consumers looking for Complainant's brands and being mischievously diverted to other inferior products. The diversion here is simply to sites not directly owned or controlled by Complainant. The citation of other Sedo landing page cases is not entirely apposite for that reason.

The Center invited Complainant to consider modifying the Complaint once it became clear that Respondent was in fact not located in United States but in Hong Kong. The Complainant did not take up that invitation, and references to the Lanham Act and constructive notice remained in the Complaint. In the Panel's view a resident of Hong Kong does not have constructive notice of a US-registered trademark no matter how famous it might be, although the extent of that fame is of course relevant to an assessment of the likelihood of *actual* knowledge.

The Complaint contains occasional overstatements, errors, submissions and artefacts more redolent of a trademark pleading than a UDRP complaint (such as "WHEREFORE, Complainant demands judgment as follows"). However, the strength of Complainant's trademarks throughout the world are such as to require some plausible explanation from Respondent if the Panel is not to draw adverse inferences from Respondent's conduct. In this case no explanation of any kind has been forthcoming and the use of a Sedo landing page to generate click-through revenue conveys a degree of sophistication on the part of Respondent that the Panel can also take into account.

Despite minor criticism of the form and content of the Complaint, the Panel formally and comfortably finds that the disputed domain name <volvo-penta.com> was registered and is being used by Respondent in bad faith.

7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <volvo-penta.com> be transferred to Complainant, Volvo Trademark Holding AB.

Philip N. Argy
Sole Panelist

Date: July 4, 2008

EXHIBIT 74



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Volvo Trademark Holding AB v. Unasi, Inc.

Case No. D2005-0556

1. The Parties

The Complainant is Volvo Trademark Holding AB, c/o AB Volvo, Goteborg, Sweden, represented by Sughrue Mion, PLLC, Washington D.C., United States of America.

The Respondent is Unasi, Inc., Panama City, Panama.

2. The Domain Names and Registrar

The domain names ("Domain Names") subjects of this Complaint are:

- <vlovo.com>
- <volvoautomobile.com>
- <volvogroup.com>
- <volvomasters.com>

The registrar is iHoldings.com Inc. d/b/a DotRegistrar.com, Colorado, Englewood, United States of America (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") by email on May 26, 2005, and sent in hard copy to the Center on May 31, 2005.

The Center acknowledged receipt of the Complaint on May 26, 2005.

On May 26, 2005, the Center sent a Request for Registrar verification to the Registrar, with the Registrar replying on May 27, 2005, confirming that the disputed Domain Names were registered with the Registrar and that the registrant contact details were correct.

The Registrar further confirmed on June 7, 2004, to the Center that the disputed Domain Name <volvomasters.com> which was due to expire on June 22, 2005, would remain under registrar lock and be automatically renewed by the Registrar at the expiry date with the winning party paying the corresponding renewal fees upon finalization of the proceeding.

On June 7, 2005, the Center requested Complainant to send copy a of the Complaint to the Registrar in accordance with the Supplemental Rules, paragraph 4(b). The same day, Complainant sent an electronic copy of the Complaint to the Registrar.

On June 8, 2005, the Center satisfied itself that the Complaint was in compliance with all formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for the Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the above, the Center issued on the same day a Notification of Complaint and Commencement of Administrative Proceeding to Respondent and sent this notification to Respondent by email, fax and by courier. The administrative proceeding commenced accordingly on June 8, 2005, and the Center set the date of June 28, 2005 as the due date for filing a response to the Complaint in accordance with paragraph 5(a) of the Rules and the Supplemental Rules.

Respondent failed to reply to the Complaint and the Center issued accordingly on July 5, 2005 a Notification of Respondent Default.

On July 15, 2005, the Center issued a Notification of Appointment of Administrative Panel informing Complainant and Respondent that it had appointed Dina Founes as the sole panelist (the "Panel") in this case following Complainant's request electing a single member Administrative Panel to decide on this dispute. The Panel found that it is properly constituted, and submitted to the Center its Statement of Acceptance and Declaration of Impartiality and Independence in compliance with paragraph 7 of the Rules.

In accordance with the paragraph 11 of the Rules, the language of proceeding shall be in English.

4. Factual Background

Complainant is the worldwide owner of the trademark and service mark VOLVO which is registered alone and in combination with other words and/or designs and is extensively used by Complainant throughout the world to designate all kinds of vehicle ranging from cars to trucks including buses and for various other associated products and services.

The VOLVO mark has been used by Complainant and its predecessors since 1927. Complainant is also using the word "Volvo" as part of its company name.

Complainant submitted, in support of its Complaint against Respondent, a list and copies of its numerous US trademark registrations (Exhibit A and B).

On June 22, 2003, Respondent registered the disputed domain name <volvomasters.com> with the Registrar.

Respondent registered three other domain names as follows: <volvogroup.com> on January 25, 2004, <volvoautomobile.com> on December 31, 2004, and <vlovo.com> on January 18, 2005, with the same Registrar.

Respondent has also been found to be the owner of numerous domain names in relation to websites displaying sponsored links to third parties commercial websites and that Respondent has a history of UDRP proceedings for undue registrations under the name of Unasi, Management Inc. (which has been evidenced by Complainant as being the same entity as Unasi, Inc.) of third parties' prior trademarks as domain names.

Uncovering the registration of the disputed Domain Name <volvomasters.com> by Respondent, a cease and desist letter was sent by Complainant through its authorized representative on March 14, 2005, requesting Respondent to transfer the disputed Domain Name to Complainant. A copy of the cease and desist letter has been attached to the Complaint.

Respondent replied electronically the same day to Complainant's representative agreeing to transfer the disputed Domain Name to Complainant if the latter accept paying the sum of US \$135.00.

On March 21, 2005, Complainant's representative informed Respondent that only the out of pocket expenses incurred by Respondent in registering the Domain Name at issue would be paid by Complainant.

On March 22, 2005, Respondent reiterated its initial offer to Complainant.

As a result, and considering the registration by Respondent of three other disputed Domain Names by Respondent including the VOLVO mark, Complainant decided to submit the Complaint to the Center.

5. Parties' Contentions

The Complainant first asserts that further to its long and extensive use of the VOLVO mark throughout the world for vehicles, aerospace equipments, and for a broad range of other related products, the word mark VOLVO has gained notoriety over the years and become a worldwide renowned trademark.

Complainant further contends that:

1) In respect of the confusing similarity between the disputed Domain Names and the VOLVO trademark:

The registered Domain Names <volvomasters.com>, <volvogroup.com> and <volvoautomobile.com> are identical or at least confusingly similar to the VOLVO trademark in which Complainant has rights as each of the Domain Names at issue wholly incorporates the VOLVO trademark, and the mere adding of the generic word such as "masters", "group" or "automobile" is not sufficient to distinguish the disputed Domain Names from Complainant's renowned trademark VOLVO. As for the <vlovo.com> disputed Domain Name, Complainant contends that Respondent had intentionally used a spelling variation of the word mark VOLVO engaging in the rising practice of "typosquatting" with the objective to take advantage of Internet users mistyping Complainant's mark VOLVO when trying to access Complainant's official websites in order to attract them to its own website(s).

2) The Respondent has no rights or legitimate interests in respect of the Domain Names given that:

- At the time Respondent selected "Volvo" as part of its Domain Names, it was under constructive notice of Complainant's trademark rights under Section 22 of Lanham act, 15 U.S.C -1072, and as a result Respondent cannot conceivably claim that it was not aware of Complainant's famous trademark VOLVO or that this trademark is not exclusively owned by Complainant.

- Respondent is not authorized by Complainant to register nor to use the VOLVO mark as part of the disputed Domain Names.

- It is obvious that Respondent is not making a legitimate non commercial or fair use of the Domain Names when Respondent's websites, to which the disputed Domain Names resolve, display sponsored links to third parties' websites for which Respondent is getting financial compensation. Respondent is thus using the disputed Domain Names for commercial gain.

3) In respect of Bad faith:

The Domain Names have been registered and used by Respondent in bad faith considering that:

- Respondent had no other reason to register the Domain Names at issue but to prevent Complainant from registering such Domain Names and/or to try to sell them to Complainant or for other commercial gain.

- Respondent was obviously aware of Complainant's prior trademark rights given that the word mark VOLVO has been famous for several decades and that it was under constructive notice of the VOLVO trademark by virtue of Section 22 of Lanham act, 15 U.S.C, 1072, and therefore the use of the Domain Names at issue is to attract Internet users to its websites in order to generate income.

- Respondent is engaged in the business of domain name warehousing considering the numerous domain names registered

and used under its name and containing third parties' trademarks as shown in Exhibit (I) of the Complaint, and the fact of registering four domain names incorporating Complainant's famous mark VOLVO further evidences such bad faith. Furthermore, Respondent has been involved in six prior UDRP proceedings where the disputed domain names were finally transferred to the trademarks owners (Exhibit O).

- Respondent offered to sell the <volvomasters.com> Domain Name to Complainant, following a cease and desist letter issued by Complainant, which has been annexed to the Complaint, at the price of US \$135.00 exceeding the reasonable out of pocket expenses normally incurred for registering the disputed domain name; such acts being additional factors supporting Respondent's bad faith.

- Respondent fails to demonstrate a legitimate use of the disputed Domain Names since the disputed Domain Names resolve only and exclusively to web pages posting sponsored links listing a great number of external websites with the purpose of taking advantage of the fame of the VOLVO mark so as to attract and then re-route Internet users to other websites with the same line of business as Complainant and generate accordingly profitable revenues to Respondent from the sponsored links.

- registering a domain name with a spelling variation as it is the case with the disputed domain name <vlovo.com> is known as 'typosquatting' and indicates Respondent's bad faith so as to attract confused Internet users ignoring the correct spelling of Complainant's mark to its unrelated commercial websites.

B. Respondent

Respondent failed to reply to the Complaint, and is therefore in default.

6. Discussion and Findings

In order to obtain the transfer of the disputed domain names, Complainant should demonstrate, in accordance with the Policy, paragraph 4(a), that:

- (i) The registered domain name is identical or similar to the trademark or service mark in which the complainant has rights.
- (ii) The respondent has no rights or legitimate interests in the domain name.
- (iii) The respondent has registered and used the domain name in bad faith.

A. Identical or Confusingly Similar

Complainant is the worldwide owner of the word mark VOLVO and derived marks containing this word in combination with other elements and has been using this brand for over 75 years to designate all kind of vehicles and other related products and services throughout the world. The word mark VOLVO is registered in various countries all over the world including the United States of America.

A list of the US trademark registrations for the word mark VOLVO has been annexed as Exhibit (A) to the Complaint, and copies of the VOLVO trademark registrations in the United States of America have been annexed as Exhibit (B) to the Complaint.

The word "Volvo" is also used by Complainant as part of its company name since at least 1935 when AB Volvo was introduced on the Stockholm stock exchange.

Complainant has provided and listed various prior WIPO panelists' decisions accepting and confirming that the word mark VOLVO constitutes one of the most famous marks worldwide. Among these decisions, see *Volvo Trademark Holding AB v. Roger Nichols*, WIPO Case No. DTV2001-0017, and see also *Volvo Trademark Holding AB v. Soeren Groenlund*, WIPO Case No. DNU2002-0003. The Panel shares the views of such reputable panelists in that the trademark VOLVO is certainly to be considered a famous trademark in view of the extensive and worldwide use by Complainant and Complainant's predecessors since 1927 and in the United States of America since 1950 of the word mark VOLVO to designate a wide range of "Volvo" vehicles and other products including airplane components and rocket engines and many other goods and services; such notoriety has been strengthened over the years considering the excellent proven quality attached to Complainant's products bearing the VOLVO mark, and accordingly this trademark has become today indubitably famous

and universally renowned.

The Panel is therefore satisfied that Complainant has duly established its exclusive and significant rights in its trademark and service mark VOLVO.

Assessing whether the disputed domain names are identical or confusingly similar:

1) in respect of the disputed domain name <vlovo.com>:

Having confirmed the notoriety status of the VOLVO mark, the Panel finds that the only difference between the disputed domain name <vlovo.com> and Complainant's trademark VOLVO is that the second letter and third letter were inverted. Therefore, the disputed Domain Name is not identical to Complainant's trademark VOLVO.

However, taking into consideration (1) the field of activities to which both the disputed Domain Name and Complainant's trademark apply (for vehicles and associated products and services), (2) the similar pronunciation and visual impression of "vlovo" and "volvo", and (3) the fame of the VOLVO trademark, the Panel finds that such alteration in the domain name's spelling (switching letters) is not sufficient to set aside the similarity between the Domain Name <vlovo.com> and Complainant's trademark VOLVO, and cannot therefore significantly differentiate it from Complainant's trademark VOLVO which remains very close visually and phonetically to the disputed domain name <vlovo.com>.

The Panel believes further that Respondent has intentionally misspelled Complainant's trademark in order to attract the flow of Internet users who have mistyped Complainant's URL address enabling Respondent accordingly to increase the traffic to its website "www.vlovo.com" and derive more revenues as a result. Such practice is known as "typosquatting" and has been clearly condemned in various panelists' decisions. See *Nasdaq Stock Market, Inc. v. Nsdaq.com, Nasdq.com and Nasaq.com*, WIPO Case No. D2001-1492; the only difference being in each case the lack of only one letter. Quite clearly respondents have sought to take advantage of Internet users typing an incorrect address when seeking to access complainant's website, a practice dubbed "typosquatting". See also *Verisign, Inc. v. Onlinemalls*, WIPO Case No. D2000-1446; respondent appears to have employed minor misspellings of complainant's mark to take bad faith advantage of spelling errors made by Internet users while attempting to enter complainant's Internet address on their web browsers... the panel determines that the disputed domain names <veresign.com> and <verasign.com> are confusingly similar to VERISIGN in the sense of paragraph 4(a)(ii) of the Policy.

Accordingly, the Panel finds that the domain name <vlovo.com> is indeed confusingly similar to Complainant's word mark VOLVO in accordance with paragraph 4(a)(i) of the Policy.

2) in respect of the disputed domain names <volvoautomobile.com>, <volvogroup.com>:

The two domain names in dispute encompass wholly the word mark VOLVO which constitutes in the Panel's opinion the sole relevant and distinctive element within the disputed Domain Names. The second elements consisting of the words "automobile" and "group" in both Domain Names at issue represent only generic or descriptive words with no legal significance or relevancy whatsoever; e.g. in the first domain name, the word "automobile" refers only to the products to which the corresponding disputed website relates, and in the second domain name the word "group" may refer to Complainant's different business entities implying that Respondent's websites "www.volvoautomobile.com" or "www.volvogroup.com" are official websites or are endorsed or belong to Complainant.

Furthermore, VOLVO is a well-known trademark worldwide, and as such the likelihood of confusion in the public's mind between the disputed Domain Names and Complainant's trademark VOLVO is greater.

As a result, Internet users may wrongfully assume that both disputed domain names belong to Complainant and accordingly the Panel finds that both disputed domain names <volvoautomobile.com> and <volvogroup.com> are confusingly similar to Complainant's trademark VOLVO which remains the predominant and central element within these contested Domain Names.

See *Toyota France and Toyota Motor Corporation v. Computer Brain*, WIPO Case No. D2002-0002; the domain name is confusingly similar to complainant's trademarks, because within the disputed domain name, there is no doubt that the predominant element is "Toyota" which is distinctive and eligible for protection per se and clearly isolable within the combination <toyota-occasions.com>. See also, *Parfums Christian Dior v. 1 Netpower, Inc.*, WIPO Case No. D2000-0022; finding that four domain names that added the descriptive words "fashion" or "cosmetics" after the trademark were confusingly similar to the trademark, See also *Société des Produits Nestlé SA v. Myongjin Kim*, WIPO Case No. D2005-0509; a domain name that incorporates the trademark NESTLE and the element "nutrition" is to be considered as confusingly similar to the various trademarks owned by Complainant.

3) in respect of the Domain Name <volvomasters.com>:

This Domain Name is a combination of 2 word elements; the word mark VOLVO attached to the word "masters"; such combination referring to the sporting golf event taking place in Spain and known as the "Volvo Masters" which is sponsored regularly by Complainant.

In the Panel's view, the fact of combining the trademark VOLVO with the word "masters" does not obliterate the distinctiveness of Complainant's trademark which remains the strong element in such combination, the word "masters" referring to the Masters golf sporting event to which it applies and which is organized by the reputable PGA Tour tournament organization.

The Panel considers that Respondent's objective registering the Domain Name <volvomasters.com> is to entertain the confusion in the public's mind and more particularly the Internet users interested in major golf tournaments by using the disputed Domain Name as to attract them into Respondent's website and redirect them afterwards to other websites selling golf equipment or other golf related services through the displayed sponsored links posted on its conflicted website page with the domain name <volvomasters.com>, and derive as a consequence further revenue by trading on the fame and goodwill of Complainant's trademark.

The Panel considers that the Domain Name in dispute <volvomasters.com> is misleading consumers and therefore is confusingly similar to the trademark VOLVO of Complainant. See *Nike, Inc. v. Farrukh Zia*, WIPO Case No. D2000-0167; finding that including a well-known trademark within a disputed domain name is misleading and as a result such domain name is to be deemed confusingly similar to Complainant's trademark.

B. Rights or Legitimate Interests

Respondent has failed to respond to the Complaint, and therefore did not submit any evidence demonstrating a legitimate use of the disputed Domain Names.

Based on the submissions made by Complainant, the Panel notes that Respondent is not related to Complainant's business and holds neither title nor any sort of permission or authorization from Complainant for the use of the word mark VOLVO as part of its Domain Names. The Panel notes also that Respondent is not using the incriminating websites to offer its own products or services, but rather to divert Internet users, who are potential clients of Complainant and therefore part of the latter's goodwill, through sponsored links displayed on its sites to other websites unrelated to Complainant's official websites and selling similar products and services to those of Complainant under different brands. Respondent's use of the Domain Names in dispute is intentionally misleading on-line consumers by re-directing them to other websites with the exclusive intention to get profits from such diversion. Such abusive use of the word mark VOLVO by Respondent which clearly harm Complainant's business and violates its trademark rights does not establish legitimate rights or interests of Respondent in the disputed Domain Names. See *Volvo trademark Holding AB v. Soeren Groenlund*, WIPO Case No. DNU2002-0003, respondent has nothing to do with complainant and complainant's business, and there are no indications whatsoever that respondent would have *bona fide* interests in relation to the trademark VOLVO. Thus the panel finds that respondent has no rights or legitimate interests in the contested domain name <volvodele.nu>. See also *Verisign, Inc. v. Onlinemalls*, *supra*; respondent's only demonstrated use of the disputed domain names has been in connection with redirecting Internet users to websites unrelated to complainant. Such use is hereafter determined to be in bad faith. Bad faith use of domain names does not establish rights or legitimate interests in the names in the sense of paragraph 4(a)(ii) of the Policy.

In view of the above findings, it is obvious that Respondent's only reason in registering and using the contested Domain Names is to benefit from the reputation of the renowned trademark VOLVO and illegitimately trade on its fame for commercial gain and profit. Such use of the Domain Names by Respondent can not constitute a *bona fide* offering of goods and services. See *Bayerish Motoren Werke AG v. Ivan Razin*, WIPO Case No. D2005-0341; the panel believes further that respondent has chosen the contested domain name <bmwcash.com> to profit from its fame and by the traffic generated by the likely initial expectations of users to whom he offers its services, a partnership for generating income from toolbar downloads and access to services of pornographic nature.

Furthermore, the Panel notes that Respondent is not commonly known as an individual, business or organization under any of the Domain Names at issue.

In light of the above, the Panel considers that none of the circumstances required under paragraph 4(c) of the Policy exist, and concludes that Respondent had no rights or legitimate interests in the disputed Domain Names.

C. Registered and Used in Bad Faith

Based on the evidence submitted in this case, the Panel is of the opinion that Respondent has registered and uses the

Domain Names in bad faith as set forth below:

- 1) Respondent was aware, at the time of registration of the disputed Domain Names, of the prior and exclusive rights held by Complainant on the VOLVO trademark. Complainant's mark is indeed, as indicated above, widely renowned due to the well established and recognized reputation of "Volvo" products worldwide combined to the fact that the "Volvo" products are extensively marketed and sold worldwide.
- 2) The Panel also resolves that Respondent's bad faith is further illustrated by the fact that it was officially informed of Complainant's rights in the VOLVO mark after receiving a cease and desist letter requesting the transfer of the first spotted disputed Domain Name <volvomasters.com> to Complainant. Respondent failed to comply with such request offering instead, which is a further indication of its bad faith, to sell the disputed Domain Name to Complainant for US \$135.00, which is in excess of the out of pocket expenses (US \$14.95) incurred by Respondent for the Domain Name's registration with the Registrar. Although the selling of the Domain Name may not appear to be the primary purpose of registering the Domain Name by Respondent, the Panel is of the opinion that Respondent by this unreasonable offer has been only guided into making again easy profit out of the Domain Name if not by successfully trading on the fame of the trademark through the website, at least by re-selling it to Complainant for an unreasonable sum exceeding by far the Domain Name registration fees paid by Respondent.
- 3) In Exhibit (H) attached to the Complaint, Complainant has brought to the attention of the Panel that Respondent has registered numerous domain names which incorporate trademarks owned by third parties, and uses them to direct traffic to other commercial websites displaying sponsored links for commercial gain. Complainant contends that Respondent is engaged in the business of warehousing domain names which constitutes further evidence of Respondent's bad faith and asserts that some of these domain names incorporate third parties' marks.

The Respondent has been involved in six (6) UDRP disputes which have condemned Respondent, as evidenced by Complainant in Exhibit O, to transfer the usurped Domain Names to the legitimate owners of the corresponding prior trademarks. This demonstrated fact of Respondent's history in UDRP proceedings combined with the registration and use by Respondent of the widely renowned trademark VOLVO within the four (4) disputed Domain Names strongly supports Respondent's involvement in domain names warehousing and therefore Respondent's bad faith in the present WIPO proceedings. See *J.P. Morgan v. Resource Marketing*, WIPO Case No. D2000-0035; the practice of registering domain names containing the trademarks of other companies can indicate that the contested domain names were registered and are being used in bad faith. Ownership of numerous domain names that corresponds to the names or marks of well-known business entities suggests intent to profit from the activities of others. See also *Nikon, Inc and Nikon Corporation v. Technilab, Inc* WIPO Case No. D2000-1774.

- 4) Complainant claims that Respondent's bad faith is further evidenced when using an incorrect spelling of the mark VOLVO within the domain Name <vlovo.com>. The Panel agrees with Complainant and determines in this regard that Respondent has no justified reason to incorporate a spelling variation in the disputed Domain Name <vlovo.com> whilst the spellings of the other three Domain Names at issue which have been registered by Respondent are totally correct. The most plausible explanation to such variation seems related to Respondent's attempt to increase its revenues and profits by additionally targeting those Internet users who mistype or ignore the proper spelling of the VOLVO mark and directing such confused consumers to different commercial websites which in return remunerate Respondent for each corresponding click-through giving access to their sites. Accordingly, the Panel decides that deliberately using misspelling variation in the disputed Domain Name constitutes a further factor of Respondent's bad faith in registering and using the Domain Name <vlovo.com>. See *Sharman License Holdings, Limited v. Icedlt.com*, WIPO Case No. D2004-0713 in which the panel found that the typosquatting facts in this proceedings evidenced respondent's bad faith in registering and using the disputed domain names. See *Nasdaq Stock Market, Inc. v. Nsdaq.com, Nasdq.com and Nasaq.com*, supra; deciding that the Internet and financial communities would be seriously confused if mistyping <nasdaq.com> would lead to the megaGo website. In short it is clearly bad faith to register three domain names that are all clearly misspellings of a world famous trademark. See also *Verisign, Inc. v. Onlinemalls*, supra.

- 5) The Panel considers further that Respondent is merely using the disputed Domain Names which include entirely the famous VOLVO trademark as an appeal brand in order to attract the interested on-line consumers in Complainant's products who would plausibly assume that Respondent's websites using the Domain Names at issue belong to or are endorsed by Complainant and then encourage consumers to divert to third parties websites through the displayed sponsored links forming the only content of its conflicted websites. Respondent, by using the disputed Domain Names, is intentionally misleading the consumers and confusing them so as to lure them to other websites making them believe that the websites behind those links are associated or recommended by Complainant. As a result, Respondent may generate unjustified revenues for each click-through by on-line consumers of the sponsored links. Respondent is therefore illegitimately capitalizing on the VOLVO trademark fame. Such finding indicates Respondent's bad faith in the registration and use of the disputed Domain Names. See *Philip Morris Incorporated v. r9.net*, WIPO Case No. D2003-0004; the disputed domain name links to a website that appears to be a fabricated "mock-up" of a web page "under construction," created for the sole purpose of displaying banners and advertisements. The home page displays <marlboro.com> in prominent letters, but otherwise is dedicated to displaying three banner advertisements: (1) a textual and banner

advertisement for Sell.com, Inc., an online classifieds company; (2) a banner advertisement for <AdultFriendFinder.com> (billing itself in the advertisement as the "world's largest sex personals"); and (3) a banner advertisement for Starluck Casino, an online gambling service. Clearly, the disputed domain name is being used intentionally to attract users to these other sites, and thus is evidence of bad faith. See also *eBay Inc. v. SGR Enterprises and Joyce Ayers*, supra; finding that since the <ebaylive.com> and <ebaystores.com> domain names and the EBAY mark are confusingly similar, an Internet user viewing a website located at such domain address would be likely to assume that the contested domain names were somehow sponsored by or affiliated with eBay. No plausible explanation exists as to why SGR and Ayers selected the name EBAY as part of the disputed domain names other than to trade on the goodwill of eBay.

6) The Panel further finds, after visiting third parties' websites to which the displayed sponsored links on Respondent's incriminating websites are offering competitors' products such as ISUZU trucks, BMW cars and many other vehicles under other well-known brands. The Panel considers accordingly that in attracting on-line consumers by using the VOLVO famous brand within the disputed Domain Names in order to re-direct such consumers to other websites promoting and selling competitors' products is a further strong indicator of Respondent's bad faith and clearly violates Complainant's trademark rights in the VOLVO mark.

In this regard, it has been deemed by numerous WIPO panels that attracting Internet traffic and diverting it to website(s) selling products of complainant's competitors by using a domain name identical or confusingly similar is evidence of bad faith under paragraph 4(b)(iv) of the Policy. See e.g. *Edmunds.com v. Ultimate Search, Inc* WIPO Case No. D2001-1319, registration and use of a domain name to redirect Internet users to websites of competing organizations constitute bad faith registration and use under the Policy. See also *Nikon, Inc and Nikon Corporation v. Technilab, Inc*, WIPO Case No. D2000-1774; the use of the <nikoncamera.com> domain name for a site that sold Nikon products and those of its competitors constitute an improper use of complainant's mark to attract Internet users to respondent's site for commercial gain by creating a likelihood of confusion as to source, sponsorship, affiliation or endorsement of the site. See also *National City Corporation v. MH Networks LLC*, WIPO Case No. D2004-0128 in which bad faith was retained for a Domain Name resolved to a website that included links to mortgage related services which in turns led to a search results page listing "sponsored links" many of which featured complainant's competitors. See also *AT&T Corp. v. Azim Hemani*, WIPO Case No. D2003-0634.

In light of all the above findings, the Panel resolves that Respondent is intentionally attempting to attract, for commercial gain, Internet users to its websites by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's websites or of the products or services posted on or linked to Respondent's websites.

The Panel considers, based on all the above elements, that Complainant has established the bad faith of Respondent in registering and using the disputed Domain Names in accordance with paragraph 4(b)(iv) of the Policy.

7. Decision

Considering the foregoing, and in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed Domain Names <vlovo.com>, <volvoautomobile.com>, <volvogroup.com> and <volvomasters> be transferred to Complainant.

Dina Founes
Sole Panelist

Dated: July 29, 2005

EXHIBIT 75



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Volvo Trademark Holding AB v. Sookwan Park

Case No. D2005-0448

1. The Parties

The Complainant is Volvo Trademark Holding AB, c/o AB Volvo, Goteborg, Sweden, represented by Sughrue Mion, PLLC, United States of America.

The Respondent is Sookwan Park, Dobong-gu, Seoul, Republic of Korea.

2. The Domain Name and Registrar

The disputed domain name <myvolvo.com> is registered with Korea Information Certificate Authority Inc. d/b/a DomainCa.com.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 27, 2005. On April 27, 2005, the Center transmitted by email to Korea Information Certificate Authority Inc. d/b/a DomainCa.com a request for registrar verification in connection with the domain name at issue. On April 28, 2005, Korea Information Certificate Authority Inc. d/b/a DomainCa.com transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the administrative, billing, and technical contact. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 2, 2005. In accordance with the Rules, paragraph 5(a), the due date for Response was May 22, 2005. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 23, 2005.

The Center appointed Ik-Hyun Seo as the Sole Panelist in this matter on May 27, 2005. The Panel finds that it was

properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant's predecessors and licensees have been selling cars, trucks, buses, construction equipment, components for airplane and rocket engines under the VOLVO trademark throughout the world for many decades, beginning in the 1920s. In this regard, Complainant owns trademark registrations for VOLVO throughout the world for various goods and services, which were registered before Respondent obtained registration for the subject domain name.

The Respondent appears to be an individual, and registered the subject domain name on April 3, 2001. The domain name is used presently to display content, and includes the following message:

"Domain name you visited is for sale. If you are a serious buyer, feel free to contact us. We will respond to your inquiry asap. Good name will support your business."

5. Parties' Contentions

A. Complainant

The disputed name is identical or confusing similar to marks in which the Complainant has rights. More specifically, Complaint asserts that it has many registrations throughout the world for the term VOLVO, and "myvolvo" is confusingly similar to VOLVO.

The Respondent has no rights or legitimate interest in the subject domain name.

Complainant has not authorized or otherwise given permission to Respondent to use Complainant's trademarks. Complainant further asserts that it is inconceivable that Respondent was not aware of Complainant's famous trademark. Moreover, the domain name is being used merely to display an offer for sale, rather than being used for a legitimate purpose.

The domain name was registered and is being used in bad faith.

Complainant contends that there is no reason for Respondent to have registered the subject domain name other than to sell it to Complainant and prevent Complainant from registering it. Complainant further contends that Respondent's bad faith is evidenced by the fact that the subject domain name is being offered for sale. Moreover, Respondent was involved in prior domain name disputes, eventually losing his domain name registration for <playboysportsbooks.com>. (*Playboy Enterprises International, Inc. v. Sookwan Park*, WIPO Case No. D2001-0778).

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

While the default language of the proceedings is Korean by virtue of the language of the relevant registration agreement and an absence of agreement otherwise between the parties, the Panel is of the opinion that it would be appropriate under the circumstances of the case to render its decision in English, as explained in more detail below.

Respondent used the subject domain name to display content in English. In fact, rather detailed instructions for buying and eventually transferring the subject domain name are provided in very capable English. Further, neither the Complainant nor their attorneys appears to have any ability to communicate in Korean, and incur additional burdens by having to rely on the assistance of translators. But most important, the Panel notes that Respondent has decided to not participate in the

proceedings, despite being served with notices from the Center in the Korean language and having received a Korean translation of the Complaint. Under these circumstances, the Panel finds it fair and more appropriate to render its decision in the language of the Complainant.

A. Identical or Confusingly Similar

The Complainant has submitted evidence of having trademark registrations for the term VOLVO, which were registered decades before Respondent obtained registration for the disputed domain name. The only difference between "myvolvo" and Complainant's trademark is the addition of "my" at the beginning of Respondent's domain name. The term "my" lacks distinctiveness and therefore has little impact when comparing the terms at issue. See *Sony Corporation v. Sin, Eonmok*, WIPO Case No. D2000-1007 (<mysony.com>). Further, given the fame and strength of the mark VOLVO, such minor additions to this mark will still render the domain name confusingly similar to the mark.

For the above reasons, the Panel finds that the first requirement has been met.

B. Rights or Legitimate Interests

Complainant has made sufficient allegations to support its contention that Respondent has no rights or legitimate interests in the subject domain name. Respondent has not responded to the Complaint or these allegations. Since the Complainant's allegations appear well-founded and reasonable on the basis of the case record before the Panel, and are undisputed by the Respondent, this Panel accepts the Complainant's assertions as true, and concludes that the second requirement has been met.

C. Registered and Used in Bad Faith

The Panel finds that there is ample evidence of bad-faith as required under paragraph 4(a)(iii) of the Policy.

First, the Panel agrees with Complainant's assertion that it is inconceivable that Respondent was unaware of Complainant's VOLVO trademark. Despite this, Respondent registered <myvolvo.com> and then displayed content offering this domain name for sale.

Further, this Panel finds persuasive the facts noted by Complainant regarding Respondent's pattern of bad-faith conduct. As noted by Complainant, the Respondent is also the registrant of various other domain names containing terms that correspond to well-known marks, which the Respondent registered and then simply offered for sale. Further, Respondent is a repeat guest to these proceedings, having lost ownership to <playboysportsbooks.com>. *Playboy Enterprises International, Inc. v. Sookwan Park*, WIPO Case No. D2001-0778.

Given the circumstances noted above, the Panel finds that the third and final element has also been established.

7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <myvolvo.com> be transferred to the Complainant.

Ik-Hyun Seo
Sole Panelist

Dated: June 10, 2005

EXHIBIT 76



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Volvo Trademark Holding AB v. Lost in Space, SA

Case No. D2002-0445

1. The Parties

The Complainant is Volvo Trademark Holding AB, a corporation organized and existing under the laws of Sweden, with a principal place of business at c/o AB Volvo, VHK, dept. 641, SE-405 08 Goteborg, Sweden. The Complainant is represented by Ms. Cynthia Clarke Weber and Ms. Leigh Ann Lindquist, Sughrue Mion, PLLC, 2100 Pennsylvania Avenue, N.W., Washington, DC 20037, United States of America.

The Respondent is Lost in Space, SA, 6th Floor, 3510 South Ramblas Blvd, Palma, Majorca, SA 1234, Spain.

2. The Domain Name and Registrar

The domain name at issue is <volvoclub.com> (the "Domain Name"). The Registrar is Intercosmos Media Group, Inc dba directNIC.com (the "Registrar"), New Orleans, United States of America.

3. Procedural History

The Complainant filed a Complaint by e-mail with the World Intellectual Property Organization Arbitration and Mediation Center (the "Center") on May 8, 2002. On May 13, 2002, the Center received a hard copy of the Complaint, with supporting evidence.

On May 13, 2002, a Request for Registrar Verification was transmitted to the Registrar, which confirmed, on the same day, that it had received a copy of the Complaint, that the Domain Name was registered with directNIC.com, and that the Respondent was the current registrant of the Domain Name. The Registrar transmitted to the Center the full whois details related to the Domain Name.

On May 22, 2002, the Center reviewed the Complaint to verify that it satisfied the formal requirements of the ICANN Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

The Sole Panelist has independently determined and agrees with the assessment of the Center that the Complaint meets the formal requirements of the Policy, the Rules and the Supplemental Rules.

The language of the administrative proceeding is English, being the language of the registration agreement.

On May 22, 2002, the Center notified the Respondent by courier and e-mail, in accordance with Paragraph 2(a) of the Rules, of the commencement of this proceeding and set June 11, 2002, as the date for the submission of a Response.

The Center did not receive a Response from the Respondent. On June 12, 2002, the Center issued a Notification of Respondent Default, which was sent by e-mail to the Parties.

On July 5, 2002, the Center invited Mr. Fabrizio La Spada to serve as Sole Panelist. On July 8, 2002, the Center received Mr. La Spada's Statement of Acceptance and Declaration of Impartiality and Independence. On July 10, 2002, the Center appointed Mr. La Spada as Sole Panelist and issued a Notification of Appointment of Administrative Panel and Projected Decision Date, which was communicated by e-mail to the Parties. The Center set July 24, 2002, as the Projected Decision Date.

The Sole Panelist finds that the Administrative Panel was properly constituted and appointed in accordance with the Rules and the Supplemental Rules.

On July 12, 2002, the Sole Panelist issued a Procedural Order No. 1, which was sent by the Center to the parties by e-mail on July 14, 2002. This Procedural Order directed the Complainant to produce documents evidencing ownership of the trademarks on which it relies in the proceeding. The Respondent was allowed to comment on the documents produced by the Complainant. August 1, 2002, was set as the new Projected Decision Date.

On July 18, 2002, the Complainant sent additional documents to the Center, by fax and courier, with a copy to the Respondent. These documents were received by the Center in hard copy on July 23, 2002. The Respondent did not file comments on the documents produced by the Complainant.

4. Factual Background

The Complainant is a corporation which handles the trademark affairs of AB Volvo and Volvo Car Corporation (the "Volvo Companies") throughout the world. It is owned equally by these two companies.

The Volvo Companies have been selling cars, trucks, buses and many other goods and services under the VOLVO name for several decades. The name VOLVO, alone and in combination with other terms and designs, is registered extensively as a trademark and service mark worldwide. It has been widely used by the Volvo Companies and their predecessors in interest since the 1920s.

In the United States of America, there are eighteen live trademarks consisting of or containing the name VOLVO. The first trademark has been registered on October 31, 1955, for "automobiles and trucktractors and parts thereof" in Class 19. The Complainant has produced evidence that several VOLVO trademarks, which were registered by the Volvo Companies, have been assigned to the Complainant in 1999.

The Respondent registered the Domain Name with the Registrar on November 19, 2001.

The Respondent set up a web site, accessible by the Domain Name, which offers escort services under the name "Temptations@Work". The Domain Name is linked to the same domain servers as the domain name <temptationsatwork.com>, which is held by the Respondent.

5. Parties' Contentions

A. Complainant

The Complainant asserts that the VOLVO mark has been extensively used throughout the world, beginning in the 1920s, in connection with cars, trucks, buses, construction equipment, components for airplane and rocket engines and many other goods and services. Moreover, the name VOLVO is registered extensively as a trademark and service mark, including in the USA, since the 1950s. The Complainant submits that the VOLVO mark has become famous by virtue of its long and extensive use, and is now one of the best known trademarks in the world, recognized as a symbol of the highest quality.

The Complainant contends that the Domain Name is confusingly similar to the VOLVO trade name and trademarks. According to the Complainant, CLUB is a descriptive, commonly used term with little or no source indicating significance.

The Complainant also submits that the Respondent has no legitimate interest in the Domain Name, based on the Complainant's continuous and long prior use of its mark and the trade name VOLVO.

The Complainant further contends that the Respondent has registered and is using the Domain Name in bad faith. According to the Complainant, there is no reason for the Respondent to use the name VOLVO in its domain name other than to attract the public to its web site for commercial gain, by creating a confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Respondent's web site and the services offered thereon. The Complainant stresses that the Domain Name links to a website which offers prostitution services or other form of selling female companionship.

The Complainant alleges that the address provided by the Respondent is not an actual address and that the Respondent itself is not a recognized entity.

The Complainant also points out that the Domain Name was previously registered in the name of another entity, which is the registrant of over 400 domain names, some of which are linked to the domain name <temptationsatwork.com>.

Finally, the Complainant submits that the Respondent was on constructive notice of the Complainant's famous VOLVO mark and chose to register the Domain Name with full knowledge of the Complainant's right.

On these basis, the Complainant seeks the transfer of the Domain Name.

B. Respondent

The Respondent has not submitted a Response nor any other comments.

6. Discussion and Findings

In accordance with Paragraph 4(a) of the Policy, in order to succeed in this proceeding and obtain the transfer of the Domain Name, the Complainant must prove that each of the three following elements are satisfied :

1. The Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (see below, section 6.1); and
2. The Respondent has no rights or legitimate interests in respect of the Domain Name (see below, section 6.2); and
3. The Domain Name has been registered and is being used in bad faith (see below, section 6.3).

Paragraph 4(a) in fine of the Policy clearly states that the burden of proving that all these elements are present lies with the Complainant.

The Sole Panelist notes that, pursuant to Paragraph 15(a) of the Rules, it shall decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable. Moreover, in accordance with Paragraph 14(b) of the Rules, if a party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules or any request from the Panel, the Panel shall draw such inferences therefrom, as it considers appropriate.

6.1 Is the Domain Name Identical or Confusingly Similar to a Trademark in Which Complainant has Rights ?

This question raises two issues : (1) does the Complainant have rights in a trademark or service mark; and (2) is the Domain Name identical or confusingly similar to such trademark or service mark.

As to the first question, the Complainant has produced clear evidence that it has rights in several VOLVO trademarks, which are registered in the United States (e.g., word mark "VOLVO" Reg. No. 636 129 registered by AB Volvo on October 23, 1956, and assigned to the Complainant on February 26, 1999).

As to the second question, the Sole Panelist finds that the Domain Name is confusingly similar to the trademark VOLVO. As numerous prior panels have held, when a domain name wholly incorporates a complainant's registered mark, that is sufficient to establish confusing similarity for purposes of the Policy (see, e.g., *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903 (November 6, 2001) ; *Magnum Piering, Inc. v. The Mudjacks and Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525 (January 29, 2001) ; *Eauto, L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc.*, WIPO Case No. D2000-0047 (March 24, 2000)). That is especially the case where the word that is added to the Complainant's trademark is not distinctive, as is the case in the present matter (addition of "club") (see *Reliant Energy, Inc. v. Brent Graeter*, WIPO Case No. D2001-0246 (April 30, 2001) ; *Freni Brembo S.p.A. v. Webs We Weave*, WIPO Case No. D2000-1717 (March 19, 2001)).

The Sole Panelist therefore finds that the Domain Name is confusingly similar to a trademark in which the Complainant has rights.

6.2 Does the Respondent Have Rights or Legitimate Interests in the Domain Name ?

The Complainants submits that the Respondent has no rights or legitimate interests in the Domain Name based on the Complainant's continuous and long prior use of the VOLVO mark and trade name. The Respondent, which did not file a Response, did not dispute this contention nor provide information as to its interests to use the Domain Name.

According to paragraph 4(c) of the Policy, a Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements :

- "(i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a bona fide offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trade mark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue."

On the basis of the statements and documents submitted, the Sole Panelist is satisfied that the Respondent has no rights or legitimate interests in the Domain Name.

The Respondent is not using the Domain Name in connection with a bona fide offering of goods or services. The Domain Name merely refers to another web site, <temptationsatwork.com>, on which escort services are offered under the name Temptations@Work. No goods or services are offered under the name "volvo" "volvoclub" or "volvo club". Moreover, there are no elements showing that the Respondent is or was commonly known by the Domain Name. Finally, there is no evidence that the Respondent is making a legitimate noncommercial or fair use of the Domain Name. On the contrary, the web site to which the Domain Name refers appears to offer services for commercial gain.

In accordance with the elements set out above, the Sole Panelist finds that the Respondent has no rights nor legitimate interests in respect of the Domain Name.

6.3 Is There Evidence of Registration and Use of the Domain Name in Bad Faith ?

Paragraph 4(b) of the Policy sets out four circumstances which, without limitation, shall be evidence of the registration and use of a domain name in bad faith. In particular, Paragraph 4(b)(iv) provides as an instance of registration and use in bad faith circumstances in which :

"by using the domain name, you [Respondent] have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location."

The Sole Panelist is satisfied that these circumstances are fulfilled in this case. First, as submitted by the Complainant and as several prior panels have held, the VOLVO trademark is a famous mark and has a worldwide reputation in connection with automobiles and other vehicles (see *Volvo Trademark Holding AB v. Cup International Limited*, WIPO Case No. D2000-0338 (June 12, 2000) ; *Volvo Trademark Holding AB v. Eurovendic (erik schroder)*, Case No. DNU2001-0001 (WIPO, April 29, 2001) ; *Volvo Trademark Holding AB v. Peter Lambe*, WIPO Case No. D2001-1292 (January 20, 2002) ; *Volvo Trademark Holding AB v. e-motordealer Ltd.*, WIPO Case No. D2002-0036 (March 22, 2002)). It is thus highly likely that the Respondent was fully aware of the existence of the Complainant and its affiliated companies and of their rights in the VOLVO trademarks at the time it registered the Domain Name.

Moreover, there is no justification in the statements and documents submitted for the use of the Complainant's trademark in the Domain Name, other than the attempt to attract, for commercial gain, Internet users to the Respondent's web site, by creating initial confusion as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site. The Sole Panelist notes that the Respondent does not use the words "volvo" or "volvo club" to offer goods and/or services through the Domain Name. On the contrary, the Domain Name merely redirects users to another web site, where no mention is made of the Domain Name or of names corresponding to the Domain Name. The Sole Panelist finds that this is further evidence that the Respondent registered and uses the Domain Name in bad faith, to benefit from the Complainant's trademarks reputation and to attract Internet users to its web site for commercial gain (see, e.g., *Microsoft Corporation v. MindKind*, WIPO Case No. D2001-0193 (April 20, 2001)).

Therefore, the Sole Panelist finds that the Domain Name was registered and is being used in bad faith.

7. Decision

On the basis of the elements set out above, the Sole Panelist finds that :

1. The domain name <volvoclub.com> is confusingly similar to the trademarks "VOLVO", in which the Complainant has rights;
2. The Respondent does not have any rights or legitimate interests in respect of the Domain Name;
3. The Domain Name was registered and is being used in bad faith.

Therefore, in accordance with Paragraphs 4(a) and 4(i) of the Policy and 15 of the Rules, the Sole Panelist orders that the Domain Name (<volvoclub.com>) be transferred to the Complainant.

Fabrizio La Spada
Sole Panelist

Dated: August 1, 2002

EXHIBIT 77



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Volvo Trademark Holding AB v. e-motordealer Ltd.

Case No. D2002-0036

1. The Parties

The Complainant in this administrative proceeding is Volvo Trademark Holding AB ("Complainant"), a corporation organized and existing under the laws of Sweden, with its main business address at c/o AB Volvo, Goteborg, Sweden. Complainant's authorised representative in this proceeding are Cynthia Clarke Weber and Leigh Ann Lindquist, a partner and associate, respectively, at Sughrue Mion, PLLC, Washington DC, U.S.A.

Respondent in this administrative proceeding is e-motordealers Ltd. ("Respondent"), an entity with its main business address at 622 Manchester Road, Crosspool, Sheffield, United Kingdom.

2. The Domain Names and Registrar

The domain name at issue is <volvoinsurance.com> ("Domain Name"), registered with VeriSign (Network Solutions Inc.) ("Registrar") located in Virginia, U.S.A.

3. Procedural History

A Complaint ("Complaint"), pursuant to the Uniform Domain Name Dispute Resolution Policy, implemented by the Internet Corporation for Assigned Names and Numbers ("ICANN") on October 24, 1999 ("Policy"), and under the Rules for Uniform Domain Name Dispute Resolution Policy, implemented by ICANN on the same date ("Rules"), was submitted to the World Intellectual Property Organization Arbitration and Mediation Center ("WIPO Center") on January 17, 2002, by e-mail and was received on January 21, 2002, in hardcopy. An amendment to Complaint was received by e-mail on January 23, 2002.

The Acknowledgement of Receipt of Complaint was submitted to the Complainant by the WIPO Center on January 23, 2002.

On January 24, 2002, a Request for Registrar Verification was transmitted to the Registrar, which confirmed on January 29, 2002, with its Verification Response that the disputed Domain Name was registered with Network Solutions Inc. and that Respondent was the current registrant of the disputed Domain Name.

The assigned WIPO Center Case Manager completed a Formal Requirements Compliance Checklist on January 30, 2002, without recording any formal deficiencies.

The Panel independently determines and agrees with the assessment of the WIPO Center that the Complaint is in formal compliance with the applicable requirements.

A Notification of Complaint and Commencement of Administrative Proceeding ("Commencement Notification") was transmitted to the Respondent on January 30, 2002, setting a deadline of February 19, 2002, by which the Respondent could file a Response to the Complaint.

On February 19, 2002, the WIPO Center received the Response to the Complaint by e-mail and on February 26, 2002, in hardcopy. The Acknowledgement of Receipt of Response was submitted to the Respondent by the WIPO Center on February 19, 2002.

Both parties elected to have the dispute decided by a single member administrative panel. The WIPO Center invited the undersigned to serve as Sole Panelist and transmitted to him a Statement of Acceptance and Request for Declaration of Impartiality and Independence which was duly signed and returned to the WIPO Center on March 5, 2002.

The WIPO Center transmitted to the parties on March 5, 2002, a Notification of Appointment of Administrative Panel and Projected Decision Date as of March 19, 2002. The Administrative Panel finds that it was properly constituted and appointed in accordance with the Policy, the Rules and the WIPO Supplemental Rules.

4. Factual Background

The following facts and statements appear from the Complaint and its annexes as well as from the Response and its enclosed documents:

Complainant is a corporation which handles the trademark affairs of AB Volvo and Volvo Car Corporation throughout the world. AB Volvo and Volvo Car Corporation each own 50% of Complainant (the Panel agrees with Complainant in using the term "Complainant" in this administrative proceeding to refer to the actual Complainant (Volvo Trademark Holding AB) and collectively to AB Volvo and Volvo Car Corporation, on behalf of which Volvo Trademark Holding AB owns the trademarks.)

Complainant has been selling cars, trucks, buses, construction equipment, components for airplane, rocket engines and many other goods and services under the VOLVO trademark throughout the world for many decades, beginning in the 1920s. The mark VOLVO, alone and in combination with other terms and designs, is registered extensively as a trademark and service mark worldwide.

One member of the Volvo Group of Companies is Volvo Financial Services which offers different services including "a variety of insurance programs targeting customers who are in the transportation industry". In some parts of the world, Volvo Financial Services operates under the trade name VOLVO INSURANCE.

In the United Kingdom, there are seventeen live trademark registrations for the VOLVO mark for a variety of goods and services. The first trademark registration in the United Kingdom is dating back to October 26, 1955. Amongst these trademarks is Trademark No. 2026532, registered on July 10, 1995, in Class 36 (Insurance; financial affairs; monetary affairs; real estate affairs.).

The Panel agrees with Complainant that by virtue of the long and extensive use, the VOLVO mark has become famous, and is a well-known trademark all over the world.

Respondent, e-motordealer Ltd., is a new company which intends "to provide a one-stop shop for all the consumer's motoring needs from sale of the car through to servicing, parts, finance and insurance through the franchised dealer network." E-motordealer has therefore registered domain names in each of these sectors of the automotive arena.

The disputed Domain Name <volvoinsurance.com> was registered by Respondent on November 28, 2001.

5. Parties' Contentions

A. Complainant

Complainant contends that:

- the Domain Name is identical and confusingly to a trademark or service mark in which the Complainant has rights; and
- the Respondent has no rights or legitimate interests in respect of the Domain Name; and
- the Domain Name was registered and is being used in bad faith; and
- the Domain Name <volvoinsurance.com> should be transferred to the Complainant.

Additional respective contentions of the Complainant may be contained in the following discussions and findings.

B. Respondent

Respondent disputes the above contentions. As a result, the Domain Name <volvoinsurance.com> should remain with the Respondent.

Additional respective contentions of the Respondent may be contained in the following discussions and findings.

6. Discussion and Findings

Paragraph 4(a) of the policy directs that the Complainant must prove **each** of the following:

- "(i) that the Domain Name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; *and*
- (ii) that the Respondent has no rights or legitimate interests in respect of the Domain Name; *and*
- (iii) that the Domain Name has been registered and is being used in bad faith."

Identical or Confusingly Similar Domain Name: Policy 4(a)(i)

The Domain Name at issue is <volvoinsurance.com>. Complainant is the holder of the registered trademark VOLVO. As rightly stated in the Complaint and upheld in *Volvo Trademark AB v. Cup International Limited*, WIPO Case No. D2000-0338; *Volvo Trademark Holding AB v. Eurovendic (erik schroder)*, WIPO Case No. DNU2001-0001; and *Volvo Trademark Holding AB v. volvoaero.com*, WIPO Case No. D2001-0723, the mark VOLVO is to be considered as a "famous mark" on the basis of its worldwide reputation in connection with the

sale of automobiles and other vehicles. Since Complainant's mark is also registered in Class 36 (Insurance; financial affairs; monetary affairs; real estate affairs.) the Panel is satisfied that the Domain Name <volvoinsurance.com> is confusingly similar to Complainant's mark VOLVO. By incorporating Complainant's popular mark with the generic term "insurance" - one of Complainant's offered services - at the end of the Domain Name, the likelihood of confusion is rather aggravated than dispelled (see *Nintendo of America, Inc. v. Tyasho Industries and Thomas G. Watson*, WIPO Case No. D2001-0976).

Additionally, the Domain Name at issue is identical to the trade name VOLVO INSURANCE, used by Complainant in some countries for marketing parts of its Financial Services.

The Panel therefore holds that the Complainant has established element (i) of the Policy's paragraph 4(a).

Respondent's Rights or Legitimate Interests in the Domain Name: Policy 4(a)(ii)

It is first convenient to recall that, according to paragraph 4(c) of the Policy, a Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

"(i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a bona fide offering of goods or services; or

(ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trade mark or service mark rights; or

(iii) you [Respondent] are making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue."

Complainant contends that Respondent has no rights or legitimate interest in the Domain Name <volvoinsurance.com> based on Complainant's continuous and long prior use of its mark VOLVO and its trade name VOLVO INSURANCE.

Respondent claims that Complainant does not have the legal right to be the sole provider of insurances for owners of Volvo Cars. Respondent asserts to have no intention to pass off as an insurance company that is part of or authorized by Complainant and holds that it has registered the Domain Name at issue for the purpose of supplying competitive quotations to Volvo drivers by providing a platform for many different insurance suppliers "to ensure the customer gets the best deal".

The Domain Name was registered on November 28, 2001. Respondent maintains that it is currently approaching potential suppliers and partners for its project and that the site referring to the Domain Name <volvoinsurance.com> is in design and expected to be functional by September 2002. A Draft Business Plan (Response Exhibit A) and a printout of the planned website (Response Exhibit P) have been provided to prove these assertions and to demonstrate Respondent's preparations to use the Domain Name in connection with a bona fide offering of goods and services.

While the Panel is satisfied that Respondent, prior to any notice of this dispute, seems to demonstrably have started preparing an offering of goods and services, it is hard to draw a bona fide connection of this to the use of the Domain Name at issue. As shown by the search for "volvo insurance" on the Altavista search engine (Response Exhibit H) and by Respondent's claim that in the UK alone, there are over 200 insurance companies that provide insurance cover on Volvo cars, it is clear that the described goods and services can be and currently are marketed and sold without using a Domain Name incorporating the mark of Complainant. Respondent refers to *DaimlerChrysler A.G. v. Donald Drummonds*, WIPO Case No. D2001-0160 where the Domain Name (<mercedeshop.com>) was found to be descriptive of the business conducted there. Respondent claims the same to be the case for this proceeding. Quoting from this Case, Respondent asserts that "in conducting the planned business it would be difficult if not impossible to altogether avoid use of the word VOLVO". The Panel disagrees. This proceeding is only concerned with the use of the word VOLVO in a Domain Name. In view of the available technology of using META-tags to increase the number of hits on search

engines, tThere is no need for Respondent to include the protected trademark VOLVO, or any other car manufacturers' protected trademarks, in the domain name in order to carry out its business. Even if the domain name did not include the component VOLVO, Respondent's web page could be found on the Internet.. Avoiding Complainant's mark in the Domain Name, therefore, would be easy and would constitute no impediment to Respondent's business.

Furthermore, Respondent maintains that Complainant's use of the trade name VOLVO INSURANCE relating to truck insurance, bus insurance and construction equipment insurance in Australia, as well as referring to credit protection insurance on credit agreements in South Africa, has no connection with Respondent's intended business of insurance for Volvo drivers in the European Union. However, by using a Domain Name of the gTLD ".com", public attention is attracted worldwide and hence conflicts with Complainant's long prior use of the trademark VOLVO and/or trade name VOLVO INSURANCE would have to be expected.

Finally, in WIPO Case No. D2001-0160 mentioned above and quoted in the Response, the Domain Name at issue was <mercedeshshop.com> and it was held that "under the present facts, if the Panel were to find for the Complainant, the majority can conceive of no case in which a legitimate competitor in the sale of parts and after-market accessories could ever register a domain name descriptive of that business." This Panel again disagrees. It does not see a vested right of anybody, particularly not of a competitor, to incorporate a famous trademark in its domain name in a manner confusing or diverting Internet users. As mentioned above, Respondent is not prevented from using the word or syllable VOLVO as a META tag on search engines in order to be visible on the Internet, nor is it prevented to use the term in a non-trademark sense on its webpage. It could even use the word or syllable VOLVO in the Domain Name, but, in view of the wording of paragraph 4(c) (iii) of the Policy, only in a *non-confusing and non-diverting manner*. By allowing the use of misleading and diverting domain names, Respondent could get a free ride and could bank on the goodwill created by the trademark holder with great investments and over a long period of time. Had Respondent registered a non-confusing domain name, identifying the trademark to belong to someone else, such as for instance: <insuranceforvolvos.com> or <volvoinsurancebroker.com> (which examples do not imply or even clearly exclude ownership, affiliation, endorsement or support by the trade mark holder), the Panel would could have taken a different view as to their admissibility. By contrast, the Domain Name chosen by Respondent at first sight appears to be one of Complainant's and it is only upon arriving at and studying the web page that the (intended) disclaimer can be seen. At that point, the consumer has already been diverted and mislead, attracted by the false impression created by the misleading Domain Name. The Policy wants to avoid this.

In the light of the above, the Panel finds that Respondent's intended use of the Domain Name does not represent a legitimate noncommercial or fair use of the Domain Name. The very composition of the Domain Name is suitable to mislead and divert consumers, at the same time tarnishing the trademark of Complainant. Thus, Complainant has fulfilled its burden of proof under paragraph 4(a)(ii) of the Policy.

Domain Name Registered and Used in Bad Faith: Policy 4(a)(iii)

The third element to be established by Complainant is that the Domain Name has been registered and used in bad faith.

Paragraph 4(b) states the following four (non-exclusive) circumstances which, if found to be present, are deemed to provide evidence of bad faith in registering and using the Domain Name:

"(i) circumstances indicating that you [Respondent] have registered or you [Respondent] have acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to the Complainant who is the owner of the trade mark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the Domain Name; or

(ii) you [Respondent] have registered the Domain Name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding Domain Name, provided that you have engaged in a pattern of such conduct; or

(iii) you [Respondent] have registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the Domain Name, you [Respondent] have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or your location."

Respondent admits that it is intending to attract Internet users to its website for the purpose of commercial gain through the offering and sale of products and services relating to VOLVO and other automobiles. As this Panel established above, the Domain Name <volvoinsurance.com> creates the likelihood of user confusion because the name itself implies the source, sponsorship, affiliation or endorsement by Complainant. The way the Domain Name is worded (without any clarifying component indicating a third party use), Respondent is trading upon Complainant's considerable goodwill and reputation, and hence infringes Complainant's registered trademark and service mark VOLVO, as well as its trade name VOLVO INSURANCE.

In the light of the above, the Panel abstains from dealing with Complainant's further contentions regarding the "for sale" character of the Domain Name, as well as the assertion that Respondent provided false contact details to Registrar. Both arguments have been contested by Respondent by presenting documents and other exhibits. However, in assessment of the facts mentioned above, the Panel concludes that both assertions are irrelevant for the outcome of this proceeding and thus can be left aside.

In conclusion, the Panel finds that the criteria of the Policy paragraph 4(b)(iv) are met and that Respondent's bad faith registration and use of the Domain Names in violation of the Policy paragraph 4(a)(iii) have been proven.

7. Decision

In view of the circumstances and facts discussed above, the Panelist decides that the disputed Domain Name is identical and confusingly similar to the registered trade mark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the Domain Name, and that the Respondent's Domain Name has been registered and is being used in bad faith.

Accordingly, pursuant to paragraph 4(i) of the Policy, the Panelist requires that the disputed Domain Name <volvoinsurance.com> shall be transferred to the Complainant.

Bernhard F. Meyer-Hauser
Sole Panelist

Dated: March 22, 2002